REMARKS

Claims 1-3, 10, 20, 22, 24-25, 27, 29-30, 44, 46-47, 49, 51-52, and 61-62 are all the claims pending in the application. Claims 1-3 and 61-62 are withdrawn from consideration pursuant to 37 C.F.R. 1.142(b) as being drawn to a nonelected invention. Claims 4-9, 11-19, 21, 23, 26, 28, 31-43, 45, 48, 50, 53-60, and 63-70 are canceled herein.

Claims 1, 20, 44 and 61 have been amended to correct dependency. Claims 3, 51, 52, and 61 have been amended for clarification purposes.

Claim 10 has been amended to incorporate the subject matter of claim 17, which has been canceled herein. Claim 10 has further been amended to recite that X represents a single bond, Y represents -CO- or -CS-, Z represents a nitrogen atom optionally substituted with C1-6 alkoky, B represents a cyclic group optionally with a substituent(s), or a pharmaceutically acceptable salt thereof. Support for this amendment can be found throughout the specification, for example, at page 46, lines 25-28.

Claim 62 has been amended to include the phrase "or a pharmaceutically acceptable salt thereof." Support for this amendment can be found, for example, at page 45, lines 13-15.

Thus, no new matter has been added herein. Entry of the Amendment is respectfully requested.

I. Response to Restriction and Election of Species Requirements

On page 2 of the Office Action, the Examiner acknowledges Applicants' election of Group I and species election of compound of Example 1(64), i.e. 4-(2-ethylbutyl)-N-(3-fluoro-5-(trifluoromethyl)phenyl)-4-hydroxy-1-piperidinecarboxamide, without traverse in the reply filed on July 9, 2009.

The Examiner indicates that the elected species reads on claims 10-17, 20, 22, 25, 27, 29-30, 44, 46-47, 49, 51-52, 55, and 57-58 and withdraws claims 1-9, 18, 19, 21, 23, 24, 26, 28, 31-43, 45, 48, 50, 53, 54, 56, and 59-65 from consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

Applicants respectfully submit to the Examiner that, in addition to the Examiner's list of claims readable on the elected species, claim 24 also reads on 4-(2-ethylbutyl)-N-(3-fluoro-5-(trifluoromethyl)phenyl)-4-hydroxy-1-piperidinecarboxamide.

Accordingly, the Examiner is requested to remove the withdrawal of claim 24.

II. Response to Claim Objections

The Examiner indicates that Applicants' species election is deemed free of art, thus examination was expanded under Markush practice to include 4-hydroxy-N-phenyl-1-piperidinecarboxamide, shown on page 3, paragraph 4 of the Office Action. The Examiner alleges that this species reads on claims 10-16, 44, 46-47, 55, and 57-58, which are rejected under 102(b) to Ashwell (see below), leaving claims 17, 20, 22, 25, 27, 29-30, and 51-52 objected to as depending from a rejected base claim.

Applicants initially point out to the Examiner that in the Office Action, the Examiner's drawing of 4-(2-ethylbutyl)-N-(3-fluoro-5-(trifluoromethyl)phenyl)-4-hydroxy-1-piperidinecarboxamide is inaccurate in that it actually depicts 4-(2-ethylbutyl)-N-(5-fluoro-3-(trifluoromethyl)phenyl)-4-hydroxy-1-piperidinecarboxamide.

With regard to the claim objections, Applicants first note that claim 17 has been canceled, thus the objection is moot as to this claim.

With regard to claims 20, 22, 24-25, 27, 29-30, and 51-52, Applicants submit that the arguments contained herein successfully overcome the 102(b) anticipation rejection over Ashwell, discussed below, rendering the objections moot.

In view of the above, withdrawal of the objection to the claims is respectfully requested.

III. Rejection of the Claims under 35 U.S.C. § 102(b)

At pages 3-4 of the Office Action, the Examiner rejects claims 10-16, 44, 46-47, 55, and 57-58 under 35 U.S.C. § 102 (b) as allegedly being anticipated by Ashwell (WO 2002/006229).

The Examiner asserts that Ashwell discloses 4-hydroxy-N-phenyl-1-piperidinecarboxamide as a reactant, reagent, or intermediate in the preparation of ß3 adrenergic receptor agonists. The Examiner further asserts that 4-hydroxy-N-phenyl-1-piperidinecarboxamide reads on present claims 10-16, 44, and 46-47, when in the formula (I), A is piperidine substituted with hydroxyl; X is a single bond; Y is -CO-; Z is -NH-; and B is phenyl.

Further, the Examiner contends that Ashwell also anticipates present claims 55 and 57-58. In this connection, the Examiner reasons that because Applicants disclose that the compounds of formula (I) can be useful as EDG-5 antagonists, and Ashwell allegedly anticipates the compounds of formula (I), it follows that the compounds of Ashwell are similarly EDG-5 antagonists, thus anticipating present claims 55 and 57-58.

Applicants initially point out that claims 11-16 are canceled herein, thus the rejection is moot as to these claims.

In response and without acquiescing to the merits of the rejection, Applicants have amended claim 10 herein to incorporate the limitations of non-rejected claim 17. Further, Applicants have amended claim 10 to define substituents X, Y, Z, and B.

Applicants submit that the 4-hydroxy-N-phenyl-1-piperidinecarboxamide compound of Ashwell does not disclose or fairly suggest the compounds of the present invention.

Accordingly, Ashwell does not anticipate present claim 10 and dependent claims 20, 22, 24-25, 27, 29-30, 44, 46-47, 49, and 51-52. Withdrawal of the rejection is respectfully requested.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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